

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Star-Telegram Operating Ltd.

Serial No.: 76/152,825

Filed: Oct. 24, 2000

Mark: LA ESTRELLA

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Int. Class: 16

Examining Attorney: M. Fromm

Law Office: 106

BOX TTAB

FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

U.S. Patent & TMO/TM Mail Rpt Dt #01
01-31-2003



NOTICE OF APPEAL

To Commissioner for Trademarks:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration. Attached herewith is the Request for Reconsideration of Final Action and Response to Office Action filed with the United States Patent and Trademark Office in regard to the above-referenced trademark application.

Respectfully submitted,

Dated: 1-28-02

Dawn C. Perotti

Dawn C. Perotti

HAYNES AND BOONE, L.L.P.
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Attorney Ref: 22343.1.08

D-1095952v1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

on January 28, 2003
Sandra Kubin

SANDRA KUBIN

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NO FEE
Commissioner for Trademarks
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Arlington, VA 22202-3513

COPY

**REQUEST FOR RECONSIDERATION OF FINAL OFFICE ACTION AND
RESPONSE TO OFFICE ACTION**

Dear Commissioner for Trademarks:

Pursuant to C.F.R. § 2.64, this is a Request for Reconsideration of the United States Trademark Office's Final Office Action dated August 13, 2002. In addition, Applicant respectfully submits herewith Applicant's response to the Final Office Action. Applicant also encloses herewith a courtesy copy of its Notice of Appeal filed with the Trademark Trial and Appeal Board.

REMARKS

The Examining Attorney has refused registration on the grounds that there is a likelihood of confusion between Applicant's mark (LA ESTRELLA) and U.S. Registration No.1,224,999 (THE STAR and Design). Applicant respectfully requests reconsideration of the application in light of the following arguments.

The decision of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) (hereinafter, "DuPont") delineates the factors to examine in determining whether a likelihood of confusion between marks exists. Of the thirteen factors enumerated by the court, the following underscore the lack of confusion in the instant case:

- (1) The large number of similar marks in use in connection with similar goods and services;

- (2) The dissimilarity of the marks; and
- (3) The dissimilarity of the goods and trade channels.

Du Pont, 476 F.2d 1357, 177 U.S.P.Q. at 567.

(1) *The large number of similar marks in use in connection with similar goods and services*

In response to the Examining Attorney's refusal to consider the third party registrations referred to in Applicant's October 1, 2001 Response, Applicant has attached hereto copies of thirty trademarks on the Principle Register containing the term "STAR" in International Class 16 and having "newspaper" or "newspapers" in the recitation of goods, including twenty-three that were allowed over the cited mark.

Below is a list of just ten of those registrations which are indicative of the many "STAR" trademarks co-existing in the newspaper industry without confusion:


<u>Reg. No.</u>	<u>Mark</u>	<u>Goods or Services</u>	<u>Owner</u>
2340358	Sing Tao Daily (translated "Star Island Daily News")	Newspaper of general circulation	Sing Tao Newspapers New York Limited
2484118	Star People ("People" disclaimed)	Publication, namely a newspaper column featuring information about motion picture film stars and other celebrities.	American Media Operations, Inc.
2606488	The Arizona Daily Star (Disclaim "Arizona Daily")	Newspapers for general circulation	Pulitzer, Inc.
2563200	Lincoln Journal Star (Disclaim "Lincoln Journal")	Daily newspaper	Lee Enterprises, Inc.
2659252	The Star-Ledger	Daily newspaper for general circulation	Newark Morning Ledger Company
1312298	The Kansas City Star (Disclaim "Kansas City")	Newspapers and magazines	Kansas City Star Company
1442073	The Minneapolis Star and Tribune (Disclaim "Minneapolis")	Daily newspapers	Cowles Media Company Corporation
1495070	Star Tribune	Daily newspapers	Cowles Media Company Corporation
1547302	Star Tribune Newspaper of the Twin Cities (Disclaim "Newspaper of the Twin Cities")	Daily newspapers	Cowles Media Company Corporation
1775176	Star Watch	Newspaper featuring stories on entertainment and sports as well as notable personalities and celebrities	Piedmont Publishing Company, Inc.


The fact that there are at least thirty-one federally registered marks that are dominated by the term "STAR", owned by twenty-three different companies, each of which is used in connection with newspapers, shows that consumers are used to distinguishing between the marks and their owners, and that the Trademark Office has repeatedly recognized this fact. So long as the Applicant's mark is ever so slightly distinguishable from these other users, which it is, as Applicant is the only one that uses the Spanish term "LA ESTRELLA" and the cited registration is limited by a significant design element, Applicant's use of THE STAR mark is not likely to cause confusion.

LA ESTRELLA does not look or sound like any of the STAR-formative marks and is easily distinguishable as a Spanish newspaper, not to be confused with the registrant's weekly magazine which is a well-known tabloid sold at supermarkets. Moreover, as Applicant is not using its mark in connection with goods or services that are directly competitive with the goods or services of the other registrants of STAR-formative marks, any likelihood of confusion is eliminated.

(2) *The dissimilarity of the marks*

Applicant's pending trademark is dissimilar to the cited mark in terms of sight, sound, and commercial impression. Merely because marks share terms does not, in and of itself, make confusion likely where the marks as a whole are dissimilar. Marks are to be considered in their entireties in determining whether a likelihood of confusion exists. *See, In re Loew's Theaters, Inc.*, 218 USPQ 956 (TTAB 1983).

First, the appearance of the respective marks are so dissimilar as to preclude a likelihood of confusion among consumers. The cited mark is a design mark ("  "). Thus as a design mark, the cited mark can be separated into two components, the appearance and the words. Since Applicant's mark is a typed mark, there is no confusing similarity of appearance. So, while the doctrine of foreign equivalents might require that the Trademark Examiner translate the term "LA ESTRELLA" to its English equivalent, trademark law also requires that the Examiner consider the appearance of the marks. "LA

ESTRELLA" does not look like registrant's design mark ("  "). Secondly, the pronunciation of the two marks is vastly different and not to be confused. Moreover, Applicant's mark puts equal emphasis on "THE" and "STAR". In contrast, registrant's design clearly emphasizes "STAR" which further accentuates for consumers that registrant's goods and services are solely focused on celebrities (also known as stars) while Applicant's mark is a commonly used term in the general circulation news business (see as examples, U.S. Reg. Nos. 0,803,925 FT. WORTH STAR TELEGRAM, 2,606,488 THE ARIZONA DAILY STAR, and 2,563,200 LINCOLN JOURNAL STAR). The different commercial impressions created by the respective marks underscores that no likelihood of confusion exists in the case at hand. In conclusion, the differences in terms of sight, sound and commercial meaning between the respective marks clearly illustrates that a likelihood of confusion between them is nonexistent.

(3) *The dissimilarity of the goods and trade channels*

Applicant respectfully submits that Applicant's goods and registrant's goods are so dissimilar in nature, especially in light of the large number of other users of the "STAR" mark, as to preclude any likelihood of confusion between the respective marks. The central inquiry in the case at hand is: "Are the goods related so that they are likely to be connected in the mind of a prospective purchaser." *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 18 USPQ2d 1587 (6th Cir. 1991) (Court ruled no likelihood of confusion between Defendant's mark HMS for real estate brokerage services promoted and sold to the general public and Plaintiff's mark HMS for real estate brokerage services promoted and sold to real estate brokers based on the rationale that if one mark's services are sold exclusively at retail level and the other exclusively to sophisticated commercial buyers, then there is little likelihood of consumer confusion). In the case at hand, the goods and trade channels of the respective marks are so different that there is little likelihood of confusion in the minds of purchasers. Registrant's good is a weekly tabloid that is in a magazine format, is 14 inches long, and is sold at grocery store check-outs in the United States to consumers who are savvy as to the type of "news" they are looking to read. In strong contrast, Applicant's

good is a daily newspaper that is in a traditional newspaper format (unfolded, it is 22 inches long) that is sold by subscription or in newspaper kiosks in Spanish speaking areas to Spanish speaking people who are interested in reading real daily local and national news. Both registrant's purchasers and Applicant's purchasers are sophisticated consumers who can distinguish between the celebrity headlines associated with registrant's magazine (for example, the January 21st cover headline is "Joe Millionaire Exposed") to the current events headlines of Applicant's Spanish newspaper. The above comparisons clearly illustrate that the goods covered by the marks at issue are not similar, nor are they remotely competitive. In addition, the likelihood of either Applicant or registrant bridging the gap between an American tabloid magazine and a Spanish newspaper is highly improbable. Finally, the target consumer bases of each mark are entirely different. Applicant markets to Spanish news readers. Registrant's consumers, on the other hand, are English speaking consumers of tabloid gossip. The promotion and sale of the goods covered by the respective marks, therefore, are made to distinct classes of consumers with little overlap.

In summary, the goods covered by the cited mark are clearly disparate from Applicant's goods. Accordingly, the response to the question of whether the goods are related so that they are likely to be connected in the mind of a prospective purchaser is a clear "no," thereby precluding any likelihood of confusion among consumers.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that there is no likelihood of confusion between the mark cited by the Trademark Office and the application for LA ESTRELLA. Accordingly, it is respectfully requested that this Request be granted and the application proceed to publication.

If there are any questions regarding the above, the undersigned can be reached at 214-651-5637.

Date: _____

1-28-02

Respectfully submitted,

Dawn Perotti

Dawn Perotti

HAYNES AND BOONE, LLP

Attorneys for Applicant

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on

January 28, 2003

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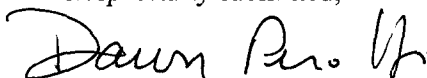
TRANSMITTAL

Enclosed are the following regarding the above-identified trademark application:

1. Notice of Appeal (in triplicate);
2. Copy of Request For Reconsideration of Final Office Action And Response to Office Action;
3. Check in the amount of \$100.00 for the fee due for Notice of Appeal;
4. the original and one copy of this Transmittal Letter; and
5. a return postcard.

The Commissioner is hereby authorized to charge payment of any further fees associated with any of the papers submitted herewith or to credit any overpayment to Deposit Account No. 08-1394.

Respectfully submitted,


Dawn C. Perotti

Date: 1-28-02

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